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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/657,457

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Hisao Furukawa

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08/11/2006

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EXAMINER

VU, VIET DUY

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/657,457	FURUKAWA ET AL.	
	Examiner	Art Unit	
	Viet Vu	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 128,176,179,183-186,194-196,405-408,421 and 422 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-27, 122-124 and 145-146 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 411,413,418 and 420 is/are objected to.
- 8) ☒ Claim(s) 128,176,179,183-186,194-196,405-408,421 and 422 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 24-27, 122-132, 135, 136, 140-150, 170-177, 179, 180, 183-186, 194-196, 201-204, 221, 223, 225, 227-230, 244, 292-297, 302-305, 334-337 and 405-422.

Continuation of Disposition of Claims: Claims rejected are 125-127, 129-132, 135, 136, 140-144, 147-150, 170-175, 177, 180, 201-204, 221, 223, 225, 227-230, 244, 292-297, 302-305, 334-337, 409, 410, 412, 414-417 and 419.

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Restriction:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 24-27, 122-127, 129-132, 135-136, 140-150, 170-175, 177, 180, 201-204, 221, 223, 225, 227-230, 244, 292-297, 302-305, 334-337 and 409-420, drawn to multiple network interconnecting, classified in class 709, subclass 249.

II. Claims 128, 176, 179, 183-186, 194-196, 405-408, 421-422, drawn to specific network interface, i.e., IP phone, classified in class 709, subclass 250.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination I as claimed do not require the particulars of the subcombination II as claimed because conventional telephones and computer terminals can be used in the invention I. The subcombination II has separate utility, i.e., IP phone interface, which enables making voice calls over IP network.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown their recognized divergent subject matter, examination of all inventions would impose a serious burden to the examiner. Therefore, restriction for examination purposes as indicated above is proper.

2. Since applicant has received an action on the merits for the originally presented invention I, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, invention II, including claims 128, 176, 179, 183-186, 194-196, 405-408, 421-422, is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

It is noted that the amendment has changed the scope of some claims making the restriction necessary for these claims.

Art Rejections:

3. The text of 35 U.S.C. 103(a) cited in the previous office action is hereby incorporated by reference.

4. Claims 125-127, 129-132, 135-136, 140-144, 147-150, 170-175, 177, 180, 201-204, 221, 223, 225, 227-230, 244, 292-297,

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302-305, 334-337, 409-410, 412, 414-417 and 419 are rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al, U.S. pat. No. 5,737,333.

Per claims 125, 127 and 131-132, Civanlar discloses an integrated information communication system comprising:

- a) a transmitting access control apparatus (101, fig. 1);
- b) a receiving access control apparatus (103, fig. 1);
- c) an network communication line (151, fig. 1) operable to provide communication between the transmitting access control apparatus and receiving access control apparatus wherein an user frame (IP packet) is inputted from a logic IP terminal (107, fig. 1) at a terminating point (sender) of an user communication, a receiver user (IP) address in the user frame is determined for enabling transferring a network frame between the transmitting access control apparatus and receiving access control apparatus (see col 5, lines 39-53).

Civanlar does not explicitly show detailed step of determining/obtaining the receiver IP address from the transmitting frame. An official notice is taken that such address extraction from IP frame header is well known in the art (see col 5, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a conventional

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IP address extraction in Civanlar because it would have enabled routing the packet to the destination node (see col 5, lines 45-53).

Per claim 126, it is obvious that the IP packet can carry any user application data including digitized voice data (see col 1, lines 13-28).

Per claim 129, Civanlar also teaches providing an address server (123, fig. 1) for use by the IP terminal to inquiry a user and/or device IP address (see col 5, lines 54-58).

Per claims 130, Civanlar teaches converting user (IP) frame into a network frame (e.g., ATM, X.25) via encapsulation for transferring the packet from the originating side to the receiving side (see col 5, lines 48-53).

Per claims 135-136, Civanlar also teaches using the address server for address lookups/conversions and address updates among IP addresses, network domains and telephone numbers, etc., (see col 6, lines 39 - col 7, line 32).

Per claims 140-141, it is noted that a user IP frame is restored from the internal network (ATM) packet by the access control apparatus 103 at the receiving side for delivering to receiving node 113 (see col 5, lines 51-53).

Civanlar does not explicitly teach charging a fee for packets routed through the network. An official notice is taken

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most data services impose a usage/connection fee for using their networks.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize such usage/connection fee in Civanlar because it would have enabled operating Civanlar's network in a practical manner.

It is further noted that any unauthorized packets (e.g., non-paid users) would have been dropped or destroyed by the access control apparatus.

Per claims 142-143, Civanlar teaches enabling communications between two hosts 107 and 113 by setting up a connection via ATM network 115 (col 5, lines 39-53), or via conventional telephone communication lines (col 5, lines 59-62).

Per claim 144, it is noted that binary code comprises "0" and "1". It is therefor obvious that address conversion/look-up table in Civandar would have comprised coded represented by "0" and "1".

Per claims 147-150, it would have been further obvious to one skilled in the art to utilize other known network adaptors in Civandar to allow communications between the ATM network and other types of communication devices and/or communication lines including portable phone line and CATV.

Per claim 170, Civandar does not teach applying measured rate or flat rate charges. An official notice is taken that the use of measured rate or flat rate for computing a connection fee is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize any known charging methods in Civandar because it would have provided more flexible charging methods to the users.

Claims 171-175, 177, 180, 201-204, 221, 223, 225, 227-230, 244, 292-297, 302-305, 334-337, 409-410, 412, 414-417 and 419 are similar in scope than that of claims 125-127, 129-132, 135-136, 140-144, 147-150 and 170.

Allowable Subject Matter:

5. Claims 24-27, 122-124 and 145-146 are allowed over prior art of record.

6. Claims 411, 413, 418 and 420 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment:

7. Applicant's arguments filed on 6/5/06 have been fully considered but they are not deemed persuasive.

Applicant alleges that Civandar does not teach a communication network for transmitting an IP frame having an IP address.

The examiner disagrees. Civandar clearly teaches communicating between users, each assigned an IP address, by using an IP packet having a source and a destination IP address transmitted via telephone lines and/or ATM network (see col 5, lines 40-62).

Applicant also alleges that Civandar does not teach converting a user frame into a network frame for transmitting through an internal network and then restoring a user frame from the network frame.

The examiner disagrees. Civandar clearly teaches converting (e.g., encapsulating) a user IP packet into ATM packet for routing through the internal ATM network then restoring the IP packet from the ATM packet for delivering to the destination host (see col 5, line 48-53).

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Conclusion:

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Friday from 7:00am to 4:00pm. The Group general information number is 571-272-2100. The Group fax number is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on 571-272-3964.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VIET D. VU
PRIMARY EXAMINER

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8/7/06